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PATENT

Patent No: 28396-6

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W. Dennis Brandon

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	Brandon, Dennis	Paper No.:
Serial No.:	10/666,387	Group Art Unit: 3671
Filed:	Sept. 18, 2003	Examiner:
For:	ADJUSTABLE SPINDLE ASSEMBLY FOR A GRASS TRIMMER	

PETITION TO ESTABLISH FILING DATE
IN RESPONSE TO NOTICE OF INCOMPLETE
NONPROVISIONAL APPLICATION

Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the notice of incomplete nonprovisional application dated January 29, 2004, in the above application, Applicant respectfully petitions pursuant to 37 CFR § 1.53(e) that the filing date of the pending Application Serial No. 10/666,387 be determined to be September 18, 2003.

On September 18, 2003, Applicant filed the current application for an "Adjustable Spindle Assembly for a Grass Trimmer," which was a divisional application of the copending Application Serial No. 09/795,645. A copy of the declaration of the inventor from the prior copending application, specifically describing the entitled invention as that described in the specification filed on February 28, 2001, was included. The current application specifically

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referenced Application Serial No. 09/795,645, and went beyond that mere reference by amending the prior specification of Application Serial No. 09/795,645 to add a new paragraph, and by amending and listing a complete set of claims. A copy of the specification from prior Application Serial No. 09/795,645, however, was not filed at that time.

The absence of the copy of the specification was not noted by the Patent Office until inquiry was made by counsel for Applicant, after the Initial Disclosure Statement had been filed, as to the status of the application. In its notice dated January 29, 2004, the Patent Office requested a copy of the specification and an oath or declaration covering that submittal, and stated that the filing date would be the date of receipt of that copy of the specification and that establishing an earlier filing date would require a petition to the Office of Petitions. In response to the notice of January 29, 2004, Applicant has submitted a copy of the requested specification and accompanying declaration under separate cover by Express Mail "Post Office to Addressee" dated January 30, 2004 (a copy is attached hereto and incorporated herein). Further, in accordance with the suggestion of the Patent Office, Applicant simultaneously submits this petition requesting that the filing date of the pending application be set as September 18, 2003.

Applicant contends that a September 18, 2003, filing date is proper because the application contains materials specifically referencing, incorporating, and amending the disclosure of copending Application Serial No. 09/795,645. See MPEP 606.01(p). The present application goes beyond a mere statement in the transmittal that the current application is a divisional application. First, it includes a declaration by the inventor that he is the inventor of the invention entitled "Adjustable Spindle Assemble [sic] for a grass trimmer," which is the name of the invention claimed in the current application, and further declares that the invention so named is described in the specification filed on February 28, 2001, and assigned Application Serial No. 795,645. Second, the present application contains

a Preliminary Amendment, also filed September 18, 2003, which requests that the Examiner amend the previous specification by adding a new paragraph before the paragraph at page 1, lines 4-7, and by canceling prior claims 1-19 and adding fully detailed claims 20-39. Thus, the referencing application includes an identification of the referenced application, and directs attention to the specific portion of the referenced application where the subject matter being incorporated may be found. See MPEP 608.01(p)(A)(¶ 4).

As discussed in In re Fouche, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971), cited in MPEP 608.01(p) a patent application may satisfy the disclosure requirement of 35 U.S.C. § 112 by reference to an earlier filed U.S. application. The referring language in question in that case was a statement in the application that a compound can be "prepared as described in Example I of our application No. ". Id. at 1238. The referencing application did not use the express words that it was "incorporating" the prior application, nor did it specifically identify the prior pending application number. However, the CCPA held that this reference was sufficient to warrant incorporation by reference because it was reasonably specific. By comparison, the current application goes far beyond what was found sufficient in In re Fouche, as the current application contains (1) a declaration specifically stating that the named invention is described in the specification filed on February 28, 2001, in the prior application, which was identified by number, and (2) a Preliminary Amendment making detailed changes to the specification of Application Serial No. 09/795,645. The intent of the Applicant to incorporate the prior specification filed on February 28, 2001, is clear, and the disclosure, including the claims contained in the Preliminary Amendment which fully describe the claimed invention, is sufficient under 35 U.S.C. § 112.

MPEP 608.01(p)(1) states that if an application as filed incorporates essential material by reference to a pending and commonly owned U.S. application, the applicant may be required to furnish the Patent Office with a copy of the referenced material together with



an appropriate declaration or affidavit. As noted above, Applicant has now complied with this requirement by submitting a copy of the referenced material and declaration. Applicant further notes that MPEP 608.01(p)(A)(2) provides that where essential material is improperly incorporated by reference to a publication or a foreign application, the filing date will not be affected because of the reference, and that the appropriate remedy is to require the applicant to amend the specification to include the referenced material. Applicant submits that the appropriate remedy in this matter similarly would be to establish the filing date as September 18, 2003, and require an amendment to the specification to include the referenced material (which has, in fact, already been completed).

Accordingly, Applicant respectfully requests that the Commissioner exercise his discretion in this matter to determine that the disclosure sufficiently meets the requirements of 35 U.S.C. § 112 and to establish a filing date for the pending application of September 18, 2003. In accordance with the suggestion of the Patent Office, Applicant further requests a refund of the petition fee of \$130.00, which accompanies this petition. Please charge any other fees required to Deposit Account No. 04-1133.

Respectfully submitted,

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